

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

INTELLECTUAL PIXELS LIMITED,
Patent Owner.

IPR2021-00237
Patent 10,681,109 B2

Before STACY B. MARGOLIES, ROBERT J. WEINSCHENK, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings on Remand
37 C.F.R. § 42.5

This proceeding is before the Board on remand from the United States Court of Appeals for the Federal Circuit. The Federal Circuit vacated our determination that Petitioner had not proven unpatentability of claims 1–18 of U.S. Patent No. 10,681,109 and remanded the case back to us. *Sony Interactive Entertainment LLC, v. Intellectual Pixels Ltd.*, No. 22-2118, 2023 WL 6773879 (Fed. Cir. Oct. 13, 2023) (Paper 41). In particular, the Federal Circuit determined that our finding that Petitioner had failed to show that Wiltshire teaches the “generating” limitation of the challenged claims is not supported by substantial evidence. *Id.* at *4. The court explained that we “erred by not crediting Wiltshire’s disclosure of applying its system to video games like Doom, which require ‘generating’ new images.” *Id.*

On December 1, 2023, the parties jointly submitted an email to the Board proposing an agreed upon procedure on remand. Ex. 3001. The parties jointly request that they each be allowed to file an opening brief, limited to ten pages, and a response brief limited to five pages. *Id.* The parties propose that the scope of this briefing be limited to the impact of the Federal Circuit’s decision on the parties’ arguments made during the *inter partes* review. *Id.* Additionally, the parties propose that they be allowed to submit briefing from the appeal but no additional evidence or expert declarations be allowed on remand. *Id.* The parties also propose a shortened oral argument to address the issues presented in the remand briefing. *Id.* We *grant* the parties request for briefing but not for oral argument at this time.

Patent Owner further seeks authorization to withdraw Forrest M. McLellan as backup counsel and seeks guidance on whether Patent Owner’s motion to exclude (Paper 31) should to be refiled. We *grant* Patent Owner authorization to withdraw Mr. McLellan. In our final written decision, we

dismissed as moot Patent Owner's motion to exclude in part. Paper 38, at 34. In view of the Federal Circuit's decision vacating our final written decision, we will reconsider Patent Owner's motion to exclude (Paper 31) on remand. The parties are not authorized to file any further motions at this time.

ORDER

Accordingly, it is

ORDERED that the parties may each file by January 18, 2024, opening briefs, limited to 10 pages;

FURTHER ORDERED that the parties may each file by February 1, 2024 response briefs, limited to 5 pages;

FURTHER ORDERED that the parties may submit briefing from the appeal to the Federal Circuit as exhibits;

FURTHER ORDERED that the parties may not submit any additional evidence or expert testimony without authorization; and

FUTHER ORDERED that Patent Owner is authorized to withdraw Forrest M. McLellan as backup counsel.

IPR2021-00237
Patent 10,681,109 B2

FOR PETITIONER:

Joseph Haag
Daniel Williams
James M. Dowd
S. Dennis Wang
WILMER CUTLER PICKERING HALE & DORR LLP
joseph.haag@wilmerhale.com
daniel.williams@wilmerhale.com
james.dowd@wilmerhale.com
dennis.wang@wilmerhale.com

FOR PATENT OWNER:

Douglas R. Wilson
Michelle E. Armond
Forrest M. McClellen
ARMOND WILSON LLP
doug.wilson@armondwilson.com
michelle.armond@armondwilson.com
forrest.mcclellen@armondwilson.com